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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,697	04/09/2004	Takuya Hayasaka	042326	8729

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EXAMINER

GRAY, LINDA LAMEY

ART UNIT PAPER NUMBER

1734

DATE MAILED: 12/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/820,697

Applicant(s)

HAYASAKA ET AL.

Examiner

Linda L. Gray

Art Unit

1734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 11-21-06.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 April 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**Detailed Action**

**Claim Rejections - 35 USC 102**

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. **Claim 1 is rejected under 35 USC 102(b) as being anticipated by Funahashi (US 3,812,782).**

**Claim 1**, Funahashi teaches a sticking roller having shaft-shaped roller body 6 and elastic member 5 which is fitted on the outer circumference surface of body 6. Body 6 has a fitted part for fitting member 5 on the outer circumference surface, see Figures 7 and 10 demonstrating part 4"/7 and part 10/8/9/13/11. Member 5 is fitted in the fitting part wherein the top surface of member 5 is arranged above the outer circumference surface (c 3, L 25, to c 6, L 54; drawings).

The limitations of "for sticking a label to an adherend" and "and contacts with a non-adhesive face of said label" each refer to an intended use of the claimed product and do not provide a patentable distinction between the claimed product and that of Funahashi. The roller of Funahashi is capable of the intended use by placing a non-adhesive side of a label on the roller and applying the label to the adherend.

The limitation of "having a circumferential surface shape which is substantially identical to the shape of said label" refers toward a material operated upon (the label) when using the claimed product in an intended use manner, and this limitation does not provide a patentable distinction between the claimed product and that of Funahashi. The roller of Funahashi is capable of operating on a label.

**Claim Rejections - 35 USC § 103**

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**4. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Damm (US 2,043,154) in view of Christoff (US 3,043,214).**

**Claims 1 and 3**, Damm teaches a sticking roller having shaft-shaped roller body 21/26 and felt member 35 which is fitted on the outer circumference surface of body 21/26. Body 21/26 has a fitted part 31/38 for fitting member 35 on the outer circumference surface (p 1, c 1, to p 2, c 2, L 19). For **claim 3**, member 35 has an expanded plan shape as shown in Figure 7.

The limitations of "for sticking a label to an adherend" and "and contacts with a non-adhesive face of said label" each refer to an intended use of the claimed product and do not provide a patentable distinction between the claimed product and that of Damm. The roller of Damm is capable of the intended use by placing a non-adhesive side of a label on the roller and applying the label to the adherend.

The limitation of "having a circumferential surface shape which is substantially identical to the shape of said label" refers toward a material operated upon (the label) when using the claimed product in an intended use manner, and this limitation does not provide a patentable distinction between the claimed product and that of Damm. The roller of Damm is capable of operating on a label.

**Claims 1 and 3**, Damm does not teach member 35 to be elastic instead of felt. It is noted that the roller of Damm is a printing roller where member 35 is the design to be printed.

However, elastic surfaces are a conventional alternative to felt surfaces in the print transfer art, as demonstrated by Christoff. Specifically, Christoff teaches using felt or rubber (i.e., elastic) on the outside of roller 19 used to transfer ink from one location to another (c 1-2; c 3, L 60-63).

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It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Damm that member 35 be rubber (i.e., elastic) instead of felt because as demonstrated by Christoff elastic surfaces are a conventional alternative to felt surfaces in the print transfer art and it is obvious to replace one material with another art recognized alternative material.

**Claim 2**, member 35 is nearly a doughnut shape (Fig 7) having a center aperture where the circumferential surface of body 21/26 is visible through the aperture.

The limitations of "when a sticking force is applied to the label on the surface of said elastic member" refers to an intended use of the claimed product and do not provide a patentable distinction between the claimed product and that of Damm. The roller of Damm is capable of the intended use by placing a label on the surface of member 5 and applying a force thereto.

The limitations of "said adherent being an information recording board which has a nearly doughnut shape in a plan view" and "corresponding to the plan shape of said information recording board" each refer to a material operated upon (the adherend) when using the claimed product in an intended use manner, and these limitations do not provide a patentable distinction between the claimed product and that of Damm. The roller of Damm is capable of operating on such an adherend.

### **Response**

**5.** Applicant's comments filed 11-21-06 have been entered and considered. With respect to the comment at page 5, paragraph 1, the limitations in claim 1 of "for sticking a label to an adherend" and "and contacts with a non-adhesive face of said label" each refer to an intended use of the claimed product and do not provide a patentable distinction between the claimed product and that of the applied prior art. The rollers of the applied prior art are capable of the intended use by placing a non-adhesive side of a label on the roller and applying the label to the adherend. The limitation of "having a circumferential surface shape which is substantially identical to the shape of said label" refers toward a material operated upon (the label) when using the claimed product in an intended use manner, and this limitation does not provide a patentable distinction between the claimed product and that of the applied prior art. The rollers of the applied prior art are capable of operating on a label. It is agreed that the label is not part of the invention in the claims. Funahashi does not teach the limitations of claim 2 and the rejection has been removed, and the claims reviewed with respect to the prior art and the new limitation in claim 3.

**Conclusion**


**6.** Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

**7.** Any inquiry concerning this communication or earlier communications from the examiner should be directed to Linda Gray whose telephone number is (571) 272-1228. The examiner can normally be reached Monday-Friday from 9:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Fiorilla, can be reached at (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public Pair. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-1997 (toll-free).

llg   
December 9, 2006

  
LINDA GRAY  
PRIMARY EXAMINER